UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

wellington

Mailed: June 9, 2005

Opposition No. 91163999

Sybaritic, Inc.

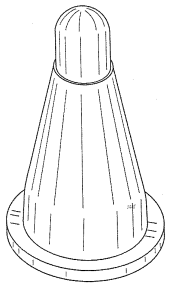
v.

Thomas P. Muchisky

Before Seeherman, Hohein, and Hairston,
Administrative Trademark Judges.

By the Board:

On August 4, 2003, Thomas P. Muchisky filed an application (Serial No. 78282661) to register the following configuration mark:[1]



The application contains the following description:

> The mark consists of the configuration of an applicator for a hand-held massager. The applicator consists of a cone-shaped attachment having a firm rubber tip.

[1] The application is based on alleged dates of first use anywhere on December 31, 1965 and first use in commerce on December 31, 1970.

On January 4, 2005, opposer filed its notice of opposition, which sets forth the following substantive allegations:

> Sybaritic, Inc., a Minnesota corporation believes it will be damaged by registration of the mark shown in application serial no. 78/282,661, which was filed on August 4, 2003, and hereby opposes the same.
>
> The grounds for opposition are as follows:
>
> 1. Opposer, Sybaritic, Inc. (hereinafter "Opposer"), is a corporation duly organized and existing under the laws of the State of Minnesota, having its principal place of business at 9220 James Avenue, Bloomington, Minnesota 55431.
> 2. The Applicant seeks to register the design of an applicator for a hand-held massager that consists of a cone-shaped attachment having a firm rubber tip as a trademark for an applicator for hand-held massager as evidenced by the publication of the mark in the Official Gazette on p. TM206 of the November 2, 2004 issue.
> 3. Upon information and belief, the applicator in the trademark application at issue includes functional aspects that cannot act as a trademark.
> 4. Upon information and belief, the applicator in the trademark application at issue has not acquired secondary meaning.
> 5. Upon information and belief, the applicator in the trademark application at issue does not function as a trademark.
> 6. If the Applicant is permitted to use and register its mark for its goods, as specified in the application herein opposed, Opposer will be damaged because it may not be able to use a similarly configured functional applicator in commerce, as it is entitled to do.
> 7. Opposer is thereby being damaged by Applicant's attempt to register the design of a hand-held massager that consists of a cone-shaped attachment having a firm rubber tip as a trademark for an applicator for hand-held massager a trademark [sic] in application serial no. 78/282,661.

(Paragraph 6 above was labeled as "5" by opposer in the notice of opposition, which we presume was an inadvertent error.)

In lieu of filing an answer, on March 7, 2005, applicant filed a motion to dismiss under Fed. R. Civ. P. 12(b)(6) based on allegations that opposer lacks standing and that the notice of opposition fails to state a claim upon which relief can be granted. As to standing, applicant argues that opposer "has not demonstrated a real interest in the opposition." Applicant acknowledges opposer's allegation in paragraph 6 of the complaint, but argues that the damage alleged by opposer is "merely conjectural or hypothetical since opposer has not alleged that it has used, is using, or will use, an applicator that is the same as, or similar to, applicant's applicator."

Applicant also argues that opposer failed to properly plead a ground for refusing registration of applicant's mark on the basis that it contains functional features because "[t]here is no indication [in the notice of opposition] as to which features of applicant's mark are functional." Applicant further argues that opposer's allegations regarding failure to function as a trademark and not having acquired secondary meaning, namely paragraphs 4 and 5, should also be disregarded in view of the examining attorney having allowed publication of the mark under Section 2(f) of the Trademark Act.

In opposition to the motion, opposer argues that it has pleaded that it will be damaged and thus has a real interest in the proceeding. Specifically, opposer relies on its

allegation in paragraph 6 of the complaint and argues that "[b]eing prevented from using a hand held massage applicator in commerce, which is a product that Sybaritic has sold and sells in commerce is a reasonable belief of damage." Opposer states that this is sufficient to allege standing to proceed with the present opposition proceeding. Opposer further states, however, that it is "being sued for trademark infringement in the United States District Court for the Eastern District of Missouri, Eastern Division[,] by General Physiotherapy, Inc. on trademarks owned by applicant." Opposer has submitted a copy of the complaint with exhibits from this civil action. As to the grounds for opposition, opposer argues that applicant is "confusing a pleading with a showing of proof" and that opposer is "not under any obligation to plead with particularity the functional aspects of the mark in the application." Opposer further states that "the fact that the Trademark Office considered the mark to be registerable as a grounds for a motion to dismiss is unreasonable" because "[e]very application that has been or is being opposed has been found to be registerable by the Trademark Office."

In order to avoid dismissal at this stage of the proceeding, opposer need only allege facts sufficient to state a claim on which relief can be granted. In other words, opposer need only allege facts in its pleading which, if proved, establish that (1) it has standing to challenge

the application, and (2) there is a valid ground for seeking to oppose registration. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982).

The standing question is an initial and basic inquiry directed solely to establishing the personal interest of the plaintiff. The Federal Circuit has stated that a party must show "a real interest" in the outcome of the case and have a "reasonable" basis for its belief of damage. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

Upon review of the notice of opposition, we find that opposer has not sufficiently pleaded its standing to maintain this proceeding. We find that opposer's pleading fails to allege facts that demonstrate it has a real interest, that is, a personal stake, in opposing the registration of applicant's mark. As noted previously, opposer argues in its brief in response to applicant's motion to dismiss that it will be damaged should applicant obtain a registration because opposer has sold and sells in commerce a hand held massage applicator and is being sued for trademark infringement by applicant's exclusive licensee in District Court.[2] However, opposer's notice of opposition is devoid of

[2] A review of the complaint (with exhibits) filed in the District Court proceeding reveals that it involves six registrations (five configuration marks and one word mark) owned by applicant for applicators for handheld massagers or other massage-related

any allegations to this effect. The fact that opposer now argues these points in its brief does not relieve opposer of the requirement to plead its standing in the notice of opposition.

Turning now to the adequacy of the pleaded grounds for opposition, we find that opposer's claim of functionality is deficient in that it fails to give fair notice as to why applicant's configuration mark is functional. The claim (contained in paragraph 3) is vague and does not specify what aspect(s) of applicant's proposed mark opposer considers to be functional. That is, paragraph 3 of the notice of opposition does not set forth with sufficient particularity the specific functional feature(s) of applicant's mark.

However, we find that opposer has sufficiently pleaded its other claims in the notice of opposition that applicant's mark fails to function as a trademark and has not acquired secondary meaning. Of course, these claims remain to be proven either at trial or upon a motion for summary judgment should this proceeding go forward.

In view of the foregoing, applicant's motion to dismiss the opposition is granted to the extent that **opposer is allowed until twenty days from the mailing date stamped on this order to file an amended notice of opposition in which**

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apparatus. Neither party has moved to suspend proceedings herein pending disposition of the District Court civil action; moreover, we note the marks involved in the civil action do not appear to be

opposer properly pleads (a) its standing to be heard in this proceeding and (b) a specific claim of functionality, failing which the opposition and/or the claim of functionality will be dismissed with prejudice. If opposer files an amended notice of opposition, applicant is allowed until thirty days after the date of service thereof to file his answer thereto.

Proceedings otherwise remain suspended.[3]

* * *

similar enough to applicant's applied-for mark to warrant suspension of this proceeding. See TBMP § 510 (2d ed. rev. 2004).

[3] The Board will issue a resumption order, rescheduling the discovery deadline and trial dates, upon receiving an amended complaint and answer thereto.